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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194358
Party	Defendant Jeffrey Pancer
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COMEDY HALL OF FAME, INC.		)	
		)	
	Opposer,	)	
v.		)	Opposition No. 91194358
		)	
JEFFREY PANCER		)	Serial No. 76/621097
		)	
	Applicant.	)	
		)	

Pursuant to Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) 502.03, Applicant, Jeffrey Pancer, through his counsel, files this reply brief in support of its motion to compel.

Applicant's interrogatories for which responses are compelled are directed to two very specific factual elements of Opposer's Complaint and perfectly permissible under the rules of discovery. Opposer's argument that the interrogatories are objectionable comes from a wholly unsupported belief that Applicant is seeking an identification of Opposer's trial evidence. Opposer's Response at 2-3. Reviewing the interrogatories in question will demonstrate conclusively that Applicant has not asked for information about Opposer's trial strategy in any way.

To be sure, merely seeking evidence that is relevant to the case and could be used at a trial is not tantamount to demanding to know what Opposer's trial evidence is. Thus, Opposer's reliance on Times Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1656 to deny discovery here is wholly misguided. The Times Warner case stands for the accepted proposition that a party need not be forced to identify its trial evidence and fact witnesses in advance of trial:

It is settled that a party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial. See, e.g., British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197 (TTAB 1993), aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040 (TTAB 1989); TBMP §419(7). **We find applicant's interrogatory requests that opposer "identify each and every fact, document and witness in support of its pleaded allegations" to be equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper.**

Times Warner, 65 USPQ2d at 1656 (emphasis added).

Here, Applicant's interrogatory requests were not constructed as general catch-all requests nor were they propounded to force Opposer to identify its trial witnesses and trial evidence.<sup>1</sup> To be sure, there is nothing wrong with asking for documents that support a specific allegation made by a party. TBMP Rule 406.02, states:

Interrogatories may seek any information which is discoverable under FRCP 26(b)(1). An interrogatory which is otherwise proper is not necessarily objectionable merely because it requires a party to give an opinion or contention that relates to fact or the application of law to fact.

Under the Federal Rules of Civil Procedure, a party is allowed to ask about the substance of, and the other party's support for, any "Allegation X". For example it may ask: "Identify all the documents that support your allegation that you used the mark on November 6, 2005." And if paragraph 15 of the Notice of Opposition stated "Opposer used the mark on November 6, 2005, then an interrogatory asking "identify all documents that support the allegation stated in Paragraph 15" is equally permissible. Again, under Rule 406.02, the mere fact that

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<sup>1</sup> Opposer's Allegation X argument misses the mark completely when it concludes that the "which you intend to use at trial" language is not necessary in the context of the interrogatories at issue to render them objectionable.

an interrogatory requires the responding party to contend whether a particular fact or document relates to the allegation is not otherwise objectionable—and here no such other objection has been made. Accordingly, the interrogatories subject to Applicant's motion to compel are unobjectionable and Opposer should be compelled to answer them.

**II. Opposer's Response Contains Admissions That Opposer Did Not Produce Documents As They Were Kept In The Normal Course of Business.**

Opposer's argument that it provided documents as kept by its client in the normal course of business is patently false. Opposer simply dumped its responsive documents in an unorganized mess on Applicant—and Opposer never disputes that there was no organization whatsoever of the documents provided to Applicant.

By its own admission, Opposer notes in Opposer's Response that there were "years of files to review" (page 3) and that Opposer's files "are organized according to categories" (page 4). However, the documents provided to Applicant were not organized by category. Further, if it is true that there were "years of files to review", then the documents provided to Applicant could not possibly have been provided as they were kept in the normal course of business. The "ordinary course of business" exception to organizing and labeling discovery responses on which Opposer is attempting to rely, requires Opposer to produce all of the years of files in its organized-by-category files – not just select documents culled from those files. To be sure, Applicant did not receive years of files in organized folders arranged by category. The fact that the documents were culled from the "category" folders is admission enough that the documents were not produced to Applicant in the ordinary course of business—and should have been labeled.

Further, Opposer's self-described "modest amount of documents as produced" (page 5) is not in any way consistent with Opposer having "years of files." While Applicant will wait to take depositions to determine the extent of the documents maintained by Opposer and whether further discovery motions will be needed to explore the issue of why only 300 documents in total were produced from "years of files", for now it will be sufficient for Opposer to simply label and index those documents that it did produce thus far – as is required by TBMP Rule 409.02.

**III. The Discovery Extensions Required By This Motion Need Not and Should Not Be The Same For Each Party.**

Opposer's argument for extending discovery to one party is predicated on a ruling that its position with respect to Applicant's discovery requests was proper. Applicant submits that Opposer has the test backward. Applicant has been hampered from conducting follow up discovery and depositions until it gets the answers and information it is entitled to obtain from Opposer. Applicant has been prejudiced by having to make this Motion, not just because of the cost associated with it, but because it needs a resolution of the issues involved before it can proceed with discovery. If the Board finds in Applicant's favor on its Motion to Compel, Applicant is entitled to a restoration of the discovery time it lost as it waited for a resolution of these issues.

Conversely, the instant Motion has not prejudiced Opposer in any way with respect to discovery because Opposer propounded no discovery prior to Applicant's filing its Motion to Compel. Opposer should not benefit from its failure to comply with Board rules and procedures to get a discovery extension commensurate with that of Applicant.

**V. Conclusion**

As detailed above, Opposer's failure to answer certain interrogatories and reasonably organize its document production merits granting Opposer's motion to compel. The Trial Calendar for this matter should be reset in a manner consistent with allowing for fair discovery.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of Applicant's Reply Brief in Support of Its Motion to Compel was served by email and First Class Mail, postage prepaid, on this 12th day of November 2010 on the following:

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